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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,867	06/01/2001	Peter J. Malnekoff	MAL611SP001IUS	2171
4743	7590	05/05/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			KEMPER, MELANIE A	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/871,867	MALNEKOFF, PETER J. <i>MW</i>	
	<b>Examiner</b>	<b>Art Unit</b>	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 February 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

*1-15, 18, 19*

- 4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15, 18, 19 is/are rejected.  
 7) Claim(s) 16-17 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15,18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal, patent number 6,239,867 in view of Newman et al., "A Multimedia Solution to Productivity Gridlock: A Re-Engineered Jewelry Appraisal System at Zale Corporation" MIS Quarterly, v. 18, n. 1, 3/1994 further in view of Taido, 10-91646.

Aggarwal teaches an input device for receiving gemstone data including cut type, weight, color, clarity, girdle thickness (see at least col. 3, lines 25-65, col. 4, lines 15-40, col. 14, lines 40-65); a processing device for computing a pricing estimate for use in a consumer evaluation report based upon the gemstone data (col. 16, lines 25-40, claims 25-26, 31); and an output device for communicating the report (col. 16, lines 35-40, col. 7, lines 5-10). Aggarwal does not clearly teach receiving predetermined gemstone data supplied by a user, however, a data file is accepted. It would have been obvious to one having ordinary skill in the art at the time of the invention to have inputted predetermined gemstone data in the automated evaluation system of Aggarwal since accepting predetermined data would have been adopted for the intended use of generating a data file of a gemstone or for the intended use of general query of the database for current market price information (col. 16, lines 25-40, claims 31, 34,35). Aggarwal also teaches the report includes a summary description, a remote communication

section, a printer for printing the report, and a display for displaying the report (see at least col. 2, lines 40-60, col. 3, lines 10-15, col. 4, lines 45-55, col. 6, lines 50-60, col. 7, lines 30-40, col. 16, lines 25-45).

Newman teaches an input device adapted to receive gemstone data supplied by a system user of the type found on a gemstone grading certificate including cut type, weight, color, clarity, and cut proportions (Table 1, p. 24); a processing device adapted to compute a pricing estimate for use in an evaluation report based upon the data received (p. 24-26); an output device adapted to communicate the evaluation report to the system user (p. 25, 27). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the predetermined gemstone information as in Newman in the system and method of Aggarwal inputting provided information would have saved time over measuring each gemstone feature. It also would have been obvious to have implemented the processing device as in Newman since this would have been adopted for the intended use of generating the current market price information used for appraisals of Aggarwal. It also would have been obvious to have included a separate price estimate for each of a plurality of types of retail outlets since this would have been adopted for the intended use of providing the market price range provided in Aggarwal/Newman such as the retailer and "off price" retailer in Newman. It also would have been obvious to have the system user be a consumer in order to allow the user to determine updated appraisal information at least for resale value or insurance purposes.

Taido teaches an input device adapted to receive predetermined gemstone data (keyboard), a processing device to compute a pricing estimate, and an output device (display) (p. 2, 11-12, 20-22). It would have been obvious to one having ordinary skill in the art at the time of the invention to have the input device (keyboard) for inputting gemstone parameters in the event that the jewelry is not available to the user, but an immediate estimate is needed.

3. Claims 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Applicant's arguments filed on 2/20/04 have been fully considered but they are not persuasive. The applicant argues that support for the portions of Aggarwal patent is not found in the provisional application, specifically, col. 16, lines 25-40. However, support is found in the provisional application as previously shown at least on pages 6,9,14 and the appraisal report. Specifically, Aggarwal teaches "This invention relates to gemstone grading systems,...data management systems wherein the aesthetic and/or monetary value of a gemstone is determined..." on the first page. Aggarwal also teaches "Yet another object of the invention is to have database capability for storing text, video, graphic, ...the database is capable of automated search, report generation, automatic input and output of data from other machines..." on page 6. "The software enables the visual display of data set reports and appraisals. The database can be queried or updated ..." and "appraisals may be transported ... forwarded to a remote

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location over the communication network" and "database and analytical software ...produce an appraisal report" on page 9. Thus support exists for the cited portions of the reference used in the rejection.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "The Real Computer Payoff: part 3" provides a date of at least April 1995 for the Jewelry Judge.

Vig, patent number 5,911,131 teaches an automated appraisal with adjustment factors (fig. 1 and related text).

No Author, "British Online Valuation Service Now Available Here" Irish Times, 7/10/98 (whole document).

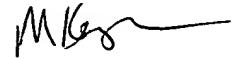
Vanier, 5828405 teaches an appraisal database (col. 6, lines 40-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



M. Kemper  
Primary Examiner  
Art Unit 3622

MK  
May 3, 2004